SEP 5 1940
CHARLES ELMORE CROPLEY
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IN THE

Supreme Court of the United States

OCTOBER TERM, 1939

No. 398

THE HAMILTON LABORATORIES, INC.
Petitioner

vs.

SAMUEL E. MASSENGILL, doing business as
THE S. E. MASSENGILL COMPANY
Respondent

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE SIXTH CIRCUIT

and

BRIEF IN SUPPORT THEREOF

W. B. MORTON
Counsel for Petitioner

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Respondent

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE SIXTH CIRCUIT

To The Honorable The Chief Justice and Associate Justices of the Supreme Court of the United States:

Your petitioner, Hamilton Laboratories, Inc., respectfully prays for a writ of certiorari to the United States Circuit Court of Appeals for the Sixth Circuit to review the decision of that Court in the above entitled case (reported 111 F. (2d) 584). (R. p. 723-30) A petition for rehearing was duly presented and denied on June 6, 1940. (R. p. 740)

A certified transcript of the record in the case, including the proceedings in said Circuit Court of Appeals is furnished herewith in compliance with Rule 38 of the rules of this Court.

Summary Statement of the Matter Involved

This is a patent infringement case. The patentee of the patent in suit discovered that chemical compounds containing mercury in a certain form were valuable pharmaceutical germicides for the treatment of blood-poisoning, gangrene, and other serious infections. In due course a patent was issued to his assignee, Hamilton Laboratories, Inc., covering pharmaceutical germicides containing compounds of mercury wherein the mercury was in the particular form found to be effective for the purposes described.

The patent is not limited to a single chemical substance of stated formula but covers a well defined group of compounds having the common characteristics of containing mercury in the form specified and having a similar action upon solution in water. (R. p. 251, col. 1, ll. 7-13)

There are a large number of such compounds possible of synthesis according to well established laws of chemistry. The patentee and his assignee made and tested some twenty different compounds and found them to have the same characteristic action and to be similarly effective against pathogenic germs. (R. p. 28) No evidence was submitted of the making of any compounds falling within the claimed group which did not have the same characteristic and effective action.

The patentee was engaged in research with compounds of the defined group for a period of years. More than two years prior to filing his application for the patent in suit, he submitted, as a candidate for a post-graduate degree, a thesis (R. p. 413) discussing certain properties of some of the compounds included in the claimed group. The thesis was typewritten and was deposited in the library of the college (Iowa State College) where the patentee was a graduate student. The copy was available to students there and to other libraries having exchange arrangements. Prior to the grant of his patent (but not more than two

years prior to his application) the patentee contributed to the recognized journals of the medical profession several articles (R. pp. 458, 469, 475) descriptive of the use of the claimed compounds in the treatment of diseases involving serious infection and at the time the patent was issued some ten or twelve manufacturers of drugs and chemicals were supplying several of the chemical compounds to the medical profession. (R. p. 42) Upon the issuance of the patent in suit all these concerns except the respondent discontinued their manufacture of the patented compounds. (R. p. 44) This suit was thereupon brought against this respondent in the District Court for the Eastern District of Tennessee where the defendant resides. The District Court dismissed the complaint, holding the patent invalid. On appeal to the Circuit Court of Appeals for the Sixth Circuit the decree of the District Court was affirmed. In its opinion the Court of Appeals based its ruling of invalidity on the following grounds:

(1) That the patentee's typewritten thesis deposited in the library of Iowa State College constituted "a printed publication" within the meaning of the patent laws. (R. p. 724)

(2) That the claims were too broad because they included within their scope compounds which had not been made and tested. (R. p. 729)

(3) That the patentee's discovery was not patentable invention because it resulted from laboratory research in a field recommended for exploration in a prior publication. (R. p. 728)

(4) As anticipated by a prior patent cited against similar claims during the prosecution of a companion application subsequently abandoned. (R. p. 730)

Questions Presented

(1) Is a typewritten thesis filed in a college library a "printed publication"?

(2) Are patents to chemical compounds and processes involving their use invalid if drawn to cover a range of equivalents beyond the specific compounds actually used?

(3) Is the discovery of new, useful and unique properties in certain chemical compounds any less a patentable invention because made in the course of research in a designated field?

(4) Is a patentee estopped to contest the pertinence of a pleaded prior patent because of its citation by the Patent Office in the prosecution of a companion application thereafter abandoned?

Reasons Relied on for the Allowance of the Writ

1. In its ruling on the significance of the patentee's typewritten thesis the Circuit Court of Appeals has decided an important question of Federal Law which has not been, but should be, settled by this Court.

In holding that such a document constitutes a statutory bar to the validity of a patent if written more than two years (now one year) prior to the application date, the Court has enormously increased the field of search that must be investigated to determine the validity of a patent.

So far as your petitioner is aware, this Court has not heretofore construed the phrase "printed publication" (R. S. 4886) with respect to subject-matter in any way analogous to that presented here. The ruling of the Court of Appeals is not supported by the authorities on which it purports to be founded, viz., *John Crossley and Sons* v. *Hogg*, 83 Fed. 488 and *Britton* v. *White Mfg. Co.*, 61 Fed. 93.

2. In ruling that the claims are too broad because not limited to exclude all compounds of the designated class not tried in actual practice, the Court of Appeals has decided an important question of Federal Law which has not been but should be settled by this Court.

The decision of the Circuit Court of Appeals is directly contrary to the established practice of the Patent Office and the Court of Customs and Patent Appeals governing the scope of claims granted in patents to chemical processes.

In re Ellis, 37 App. D. C. 203
In re Walker, 70 F. (2nd) 1008
Ex parte Geer, 3 U. S. Pat. Q. 131.

3. In ruling that the patent is invalid because the claimed discovery resulted from research in an indicated field, the Court of Appeals has decided an important question of Federal Law contrary to the established rule of this Court in cases involving patents for "discoveries". *Corona Co.* v. *Dovan Corp.*, 276 U. S. 358, 368-9.

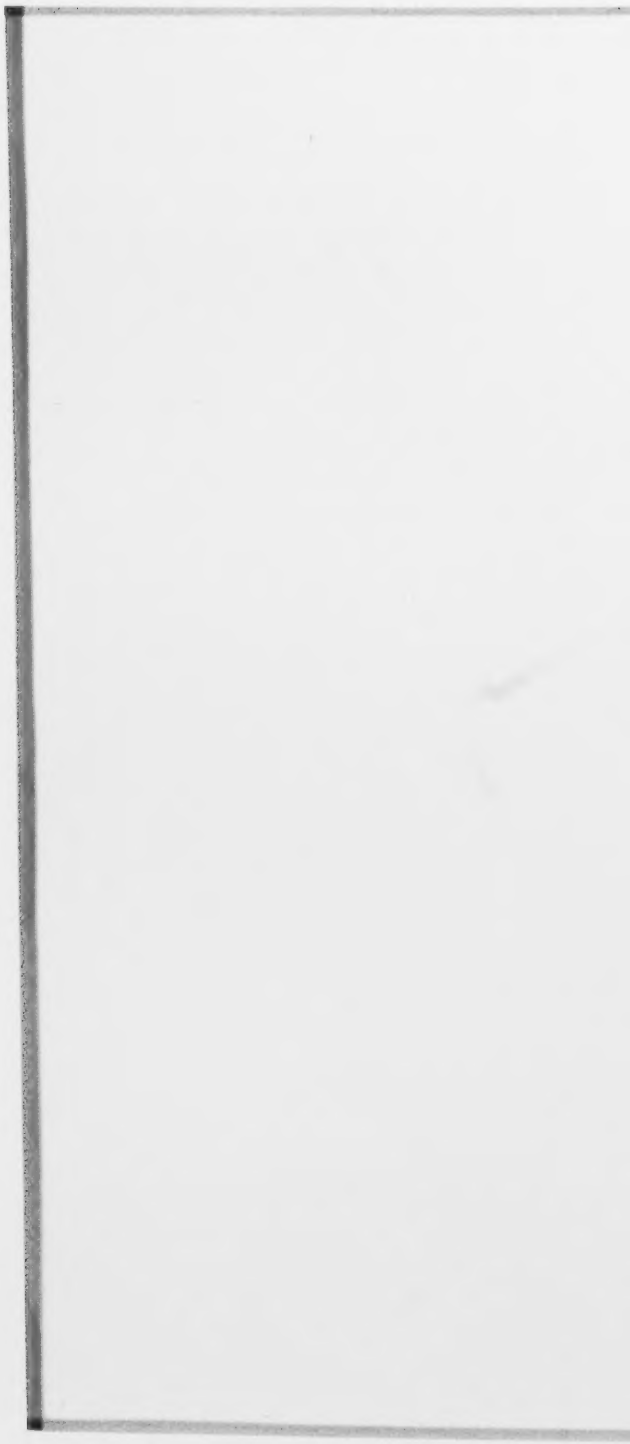
4. The Court of Appeals supports its ruling that the patent in suit is invalid because of a prior patent to the use of certain organic mercury compounds as seed disinfectants, upon the failure of the patentee to contest a rejection in the Patent Office *of a prior application* based on that patent. The prior application was later abandoned and a new application filed upon which the patent in suit was ultimately granted.

The decision of the Court of Appeals on this question is contrary to the established rule of this Court in cases involving Patent Office proceedings. *Smith* v. *Snow*, 294 U. S. 1, 16.

WHEREFORE, your petitioner respectfully prays that a writ of certiorari be issued out of and under the seal of this Honorable Court, directed to the Circuit Court of

Appeals for the Sixth Circuit, commanding that court to certify and to send to this Court for its review and determination, on a day certain to be therein named, a full and complete transcript of the record and all proceedings in the case numbered and entitled on its docket, No. 8238, Hamilton Laboratories, Inc. Appellant v. Samuel E. Massengill, doing business as The S. E. Massengill Company, Appellee, and that the said decree of the Circuit Court of Appeals for the Sixth Circuit may be reversed by this Honorable Court, and that your petitioners may have such other and further relief in the premises as to this Honorable Court may seem meet and just; and your petitioner will ever pray.

HAMILTON LABORATORIES, INC.
By W. B. MORTON,
Counsel for Petitioner



BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI

Opinions of the Courts Below

The opinion of the United States District Court for the Eastern District of Tennessee was filed November 8, 1938, appears on pages 229-236 of the record, and was reported in 25 Fed. Supp. 464. The opinion of the Circuit Court of Appeals for the Sixth Circuit was filed May 8, 1940, appears at pages 723-730 of the record, and was reported in 111 F(2nd) 584.

Jurisdiction

The jurisdiction of this Court is invoked under Section 240 (a) of the Judicial Code as amended by the Act of February 13, 1925, c. 229 (28 U. S. Code, Sec. 347). The decree of the Circuit Court of Appeals for the Sixth Circuit which petitioner seeks to have reviewed was entered May 8, 1940 (R. p. 722). Thereafter, a petition was filed for rehearing (R. p. 732), which was denied on June 6, 1940 (R. p. 740).

Statement of the Case

The essential facts of the case are stated in the accompanying petition for a writ of certiorari. Any necessary elaboration of the facts will be made in the course of the argument which follows.

Specification of Errors

The errors which petitioner will urge, if the writ of certiorari is issued, are that the Circuit Court of Appeals for the Sixth Circuit erred:

1. In holding that the typewritten thesis prepared by the patentee summarizing his experimental work at Iowa State College and deposited in the library of the college, constitutes a printed publication under the provisions of R. S. 4886, 35 U. S. Code, Sec. 31.

2. In holding that the claims of the patent in suit are invalid because they include within their scope compounds of the designated class in addition to those specifically employed.

3. In holding that the claims of the patent are invalid because directed to a discovery made pursuant to chemical research in an indicated field.

4. In holding that the claims of the patent in suit were anticipated by Kharasch U. S. Patent No. 1,770,886 cited by the Patent Office against the patentee's prior and abandoned application.

5. In affirming the decree of the District Court in favor of respondent and holding the patent in suit invalid.

Summary of Argument.

The points of argument will follow the reasons relied upon for allowance of the writ of certiorari and will be discussed in the order set out in the petition (ante, pp. 4-5).

ARGUMENT.

I.

THE TYPEWRITTEN THESIS (Rec. p. 413) DEPOSITED BY THE PATENTEE IN THE IOWA STATE COLLEGE LIBRARY WAS NOT A PRINTED PUBLICATION WITHIN THE MEANING OF R. S. 4886, U. S. CODE, TITLE 35, SEC. 31.

So far as we are aware, this Court has never had occasion to construe the phrase "printed publication" of R. S.

4886 in its application to facts in any way analogous to those here presented.

In *Corona* v. *Dovan,* 276 U. S. 358, the invention of the patent in suit had been described in detail in a paper read before the American Chemical Society more than two years prior to the application for the patent. The District Court held that this paper so read did not constitute a printed publication within the meaning of the statute, and that ruling was not assigned as error in the later proceedings in the case.

The two cases relied upon by the Court of Appeals for the Sixth Circuit in support of their opinion are not in fact relevant to the question presented. In *John Crossley & Sons, Ltd.,* v. *Hogg,* 83 Fed. 488, the patent in suit was a design patent. The ground of rejection was a lithographic plate contained in a printed book published in Paris. The lithographic plate was not printed in the sense of containing letter press. It was a cut or diagram showing a carpet pattern which the Court found anticipatory of the carpet pattern constituting the subject-matter of the design patent. There was no question that the anticipating illustration of the design was part of a printed publication, in fact that question seems not to have been raised.

In *Britton* v. *White,* 61 Fed. 93, the question presented was whether an illustration of a carriage lamp in "The Coachmaker's Monthly Magazine" was an anticipation. The Court said (p. 95):

> "I think the Saladee Coachmaker's Monthly Magazine is admissible as a printed publication, to show the state of the art. The number containing this lamp in question has printed on it, 'New York, April, 1855', is bound up with other numbers for the years 1855 and 1856, and refers to its advertisements, and gives terms therefor. It purports to be printed for general circulation, and is characterized as a publication by the witnesses for defendant. These circumstances furnish sufficient prima facie evidence of publication."

There seems to be no sound basis for the decision of the Court of Appeals for the Sixth Circuit holding this thesis to be a printed publication. The expression "printed publication" has a very definite meaning, both legally and in the ordinary useage of the language. Giving the words their ordinary and intended significance, a printed publication is a magazine, book, newspaper, or the like, intended for general distribution, which is the obvious and correct interpretation of the statute as expressed in the language of the Court in *Britton* v. *White,* supra.

It is important that this Court review this decision of the Court of Appeals for the Sixth Circuit. Industrial development in modern times is largely founded on research, and this research frequently involves several years of intensive work before commercial results are obtained. Against the defense of prior knowledge or prior use, the inventor may show his own priority and his diligence in perfecting his invention. Against a "printed publication" of a date more than one year prior to his patent application, he has no defense, and if the decision of the Court of Appeals with respect to the patentee's thesis is a correct interpretation of the law, patents to many valuable inventions will be invalidated.*

Moreover, the decision of the Circuit Court of Appeals for the Sixth Circuit puts all these thousands of college papers not only in this country, but throughout the world, in the "prior art" and thus enormously increases the field of search in which anticipatory matter may be found. Obviously no such conditions were contemplated by the framers of the statute.

***In the present case the thesis (R. p. 413) does not disclose the invention of the patent. It was written at too early a stage in the course of the inventor's research and fails to disclose certain essential characteristics of the invention which had not been discovered at that time.**

II.

PATENT CLAIMS TO A DEFINED GROUP OF CHEMICAL COMPOUNDS POSSESSING THE ESSENTIAL CHARACTERISTICS FOR THE STATED PURPOSE ARE NOT INVALID. (*The Incandescent Lamp Patent,* 159 U. S. 465)

The pertinent facts as found in the Court's opinion are:

There are a great many possible compounds falling within the broad definition of organic mercury compounds (Rec. p. 201), although probably not over thirty or forty ever got beyond the stage of a laboratory sample (R. 214). In this vast field the patentee discovered a smaller, well defined class of related products having certain features in common, namely, that the mercury was contained in the same combined form and that they had a similar action upon solution in water. The compounds within this class had extraordinary germicidal power and yet were inoccuous to man when administered in concentrations to be lethal to pathogenic germs. The patentee discovered these characteristics in one substance in this class by the usual process of laboratory research (Rec. pp. 112, 443). He attributed the effectiveness of the compound to those characteristics which identified the compound with the defined group. That deduction was confirmed by making up and trying out some twenty other compounds belonging to the defined group, and they were found to possess the same characteristics (Rec. p. 28). He therefore sought and obtained under the established practice of the Patent Office a patent, listing a number of the specific individual compound which had been used and claiming the defined group. The rule of the Patent Office is thus stated in a typical decision of the Board of Appeals:

> *Ex Parte William C. Geer and Harry L. Fisher,* 3 U.S.P.Q. 131, 132:

> "The second test applies where the class and reaction are not so clearly defined and involved. In such case it is required that applicant give a number of examples of compounds which he has found to be operative in the relation involved in his invention. If these several tested materials appear to have some characteristic in common which is the essential characteristic which makes them operative in the relation involved so that it may be expected that other members of that class of materials would act the same, he may have a claim broad enough to include that class."

The rule was established by the Court of Appeals for the District of Columbia when that Court had appellate jurisdiction in Patent Office cases (*In re Ellis*, 37 App. D.C. 203) and has been restated by the Court of Customs and Patent Appeals (*In re Walker*, 70 F(2nd) 1008).

Although apparently the question has not been passed upon directly by this Court, the Patent Office rule is founded on the opinion of this Court in the Incandescent Lamp Patent (159 U. S. 465), which was quoted with approval in *Corona* v. *Dovan*, supra.*

The state of facts presented by this case is becoming more and more common with the great advance in industrial chemistry, particularly in the production of synthetic products. There should be an authoritative ruling by this Court on this question, decided, as we submit, in error by the Circuit Court of Appeals for the Sixth Circuit.

***In both these cases this Court held claims to a class of substances invalid because it was shown that there was "no general quality" common to the whole class and that many substances within the defined class were in fact useless.**

III.

THE CLAIMS OF THE PATENT ARE NOT INVALID BECAUSE BASED ON A DISCOVERY MADE IN THE COURSE OF RESEARCH IN A FIELD RECOMMENDED FOR STUDY IN A PRIOR PUBLICATION. (*Corona* v. *Dovan*, 276 U. S. 358)

This publication, the White article is entitled "New Organic Mercurials and Their Therapeutic Applications". None of the "new organic mercurials" discussed in the article are within the group claimed by the patentee here. The entire pertinency of the article is found in two paragraphs in the introduction, which paragraphs are quoted in full in the opinion of the District Court (Rec. pp. 234-5) and repeated in the opinion of the Circuit Court of Appeals (Rec. pp. 726-7). On the basis of these introductory paragraphs the lower Court held the White article

> ". . . pointed out the whole field in which organic mercury might or might not produce compounds of such tolerable toxicity. He told those interested in the art, in effect, to take his formulae and try the various combinations within the permitted substituent groups, of which he gave a typical illustration, and that the whole story of pharmacological mercurials would unfold." (R. p. 235)

This ruling was affirmed by the Court of Appeals (Rec. p. 727).

We doubt if the White article can be so interpreted. The only suggestion as to experimentation in the entire article is in the last sentence of the matter relied upon by the Court, wherein the author, after stating that nothing of therapeutic value had been found in one general group of organic mercurial compounds, said (R. p. 625):

> "Our consideration then narrows down to substances of the first group. This is a limitation of type but not of number, for when we consider that in the group

> R we may substitute single groups or concatenations of any complexity we see that the whole gamut of aromatic chemistry may be run in the synthesis of mercurials for pharmacological study."

If this petition be granted, we shall argue that the White article was not even an invitation to experiment in the field of organic mercurials, but assuming that it was, it is our position that the decision of the Circuit Court of Appeals was in error in not holding that discoveries made in the course of research are patentable discoveries, regardless of what prompted the research, *if the thing discovered has new, useful and unique properties,* as was found by the District Court in the present case (Finding of Fact No. 21, R. pp. 240-241).

In the case of *Corona* v. *Dovan, supra,* this Court specifically so ruled. Counsel for petitioner in that case contended (276 U. S. 362):

> "To a chemist familiar in 1918 with the guanidines in general and triphenylguanidine in particular, the most natural thing in the world would have been to think of diphenylguanidine [D. P. G.] as usable for the same purpose, and every rubber chemist would have known that the only way to find out would be to try it according to the routine methods of laboratory testing."

The Court held against petitioner on this point (p. 369):

> "If employment of D.P.G. as a useful accelerator was a discovery by Weiss, prior to anyone else, Weiss, or his assignee, is entitled to all the advantages that flow from that increased activity or from any other quality in its use as such."

In its opinion (R. p. 728) the Court of Appeals, in commenting on the patentee's research which resulted in the patented discovery, said:

> "There is no convincing evidence of seemingly insuperable difficulties encountered on the road, of blind alleys, and unmarked forks, of advances and retreats, of trials and failures."

The Courts have frequently held that it is the nature of the discovery and not the trials and tribulations of the discoverer which determines the patentability of the discovery. Congress, in the report of the Senate Committee accompanying the recent revision of the patent laws to include the plant patent sections, so interprets the statute:

> "The inventor of a composition of matter may have definitely in mind the new product and definitely worked toward it. On the other hand, as is true of many of the most important inventions, he may accidentally discover the product, perhaps in the course of the regular routine of his work. He does not have to show, for instance, that he mixed the elements and expected them to produce the particular composition of matter. He *may simply find the resulting product* and have the foresight and ability to see and appreciate its possibilities and to take steps to preserve its existence.
>
> The same considerations are true of the plant breeder." (71st Congress, 2nd Session-Report No. 315, p. 11).

If the ruling of the Circuit Court of Appeals in this case be given general application, evidence in patent cases will not be directed to establishing the novelty and utility of the thing invented or described, but will consist of an elaborate recital of all the fruitless efforts that preceded the discovery.

IV.

THE PATENTEE IS NOT ESTOPPED TO CONTEST THE PERTINENCE OF A PRIOR PATENT CITED DURING THE PATENT OFFICE PROSECUTION OF A COMPANION APPLICATION. (*Smith* v. *Snow*, 294 U. S. 1)

The conflict in the Court's decision (Rec. p. 730) on this point with the rulings of this Court is in the significance attached to the citation of this patent by the Patent Office in the prosecution of a prior application which was subsequently abandoned. This Court has ruled that the cancellation of the rejected claims of an application is without significance where broad claims are ultimately obtained.

> *Smith* v. *Snow*, 294 U. S. 16:
> "It is of no moment that in the course of the proceedings in the Patent Office the rejection of narrow claims was followed by the allowance of the broader Claim 1. *Westinghouse Electric & Mfg. Co.* v. *Condit Electrical Mfg. Co.*, 194 Fed. 427, 430 (C.C.A. 2d)."

The same rule obviously applies whether the claims ultimately obtained issued on the original application or on a later filed substitute application.

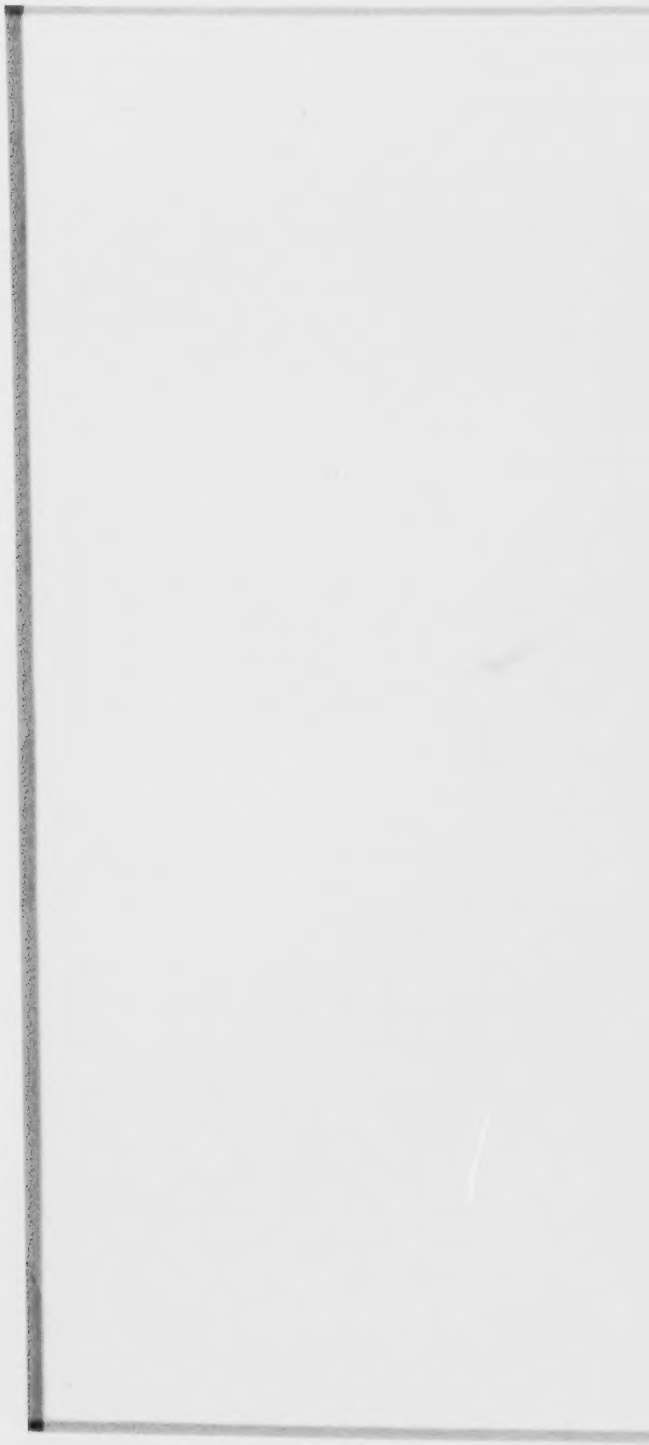
If this petition be allowed we will urge error in this finding also on the ground that, as shown by the evidence in the case, sterilizing seeds for agricultural purposes and combatting pathogenic germs in human diseases are non-analogous arts.

Conclusion

It is urged that this petition for certiorari be granted and that an authoritative ruling by this Court be made on each of the four questions here presented.

Respectfully submitted,

W. B. MORTON,
Counsel for Petitioner.



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PETITIONER'S REPLY BRIEF

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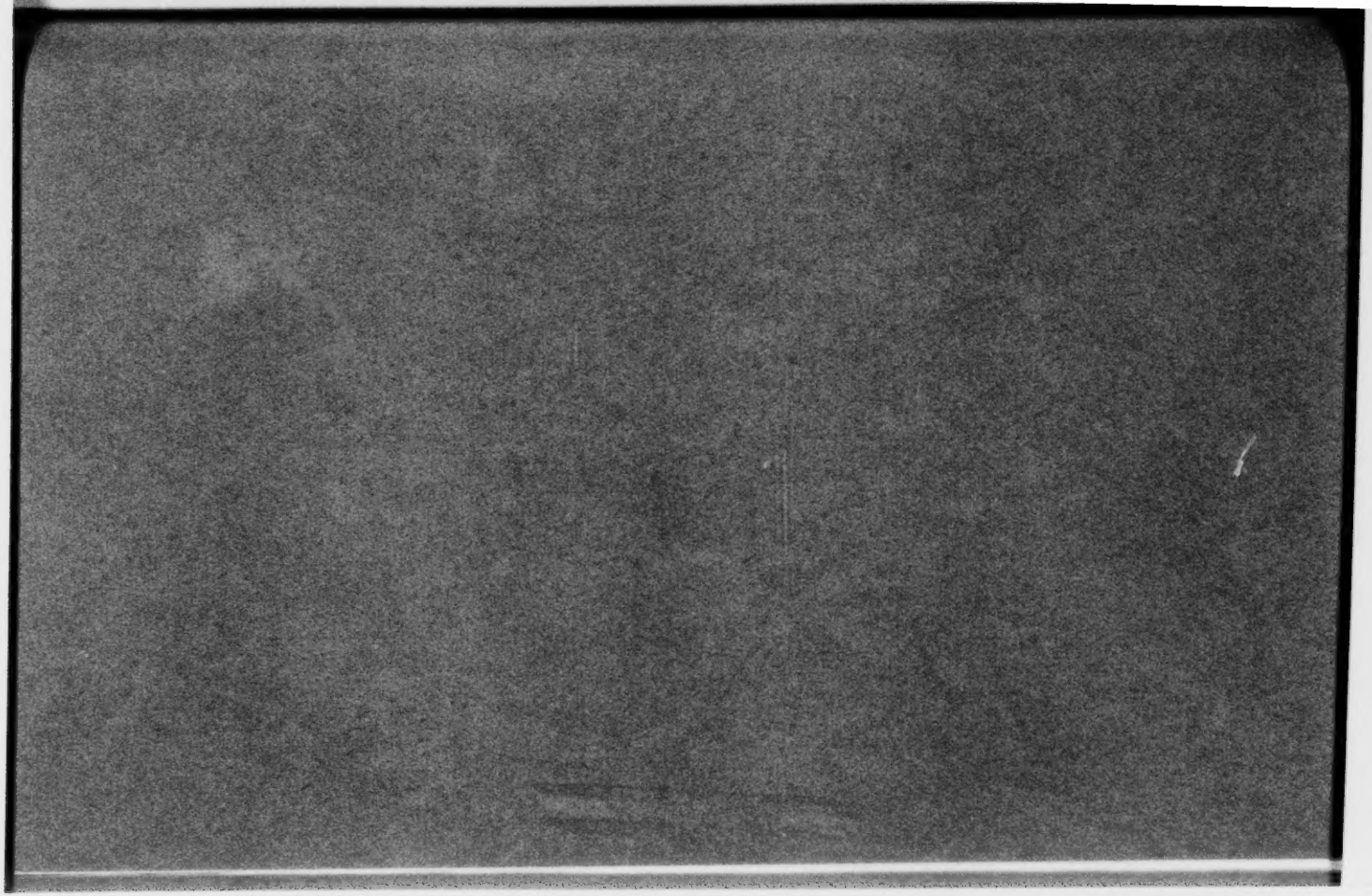
Counsel for Petitioner



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QUESTION IV. The patentee is not estopped to contest the pertinence of a prior patent cited during the Patent Office prosecution of a companion application (Smith v. Snow, 294 U. S. 1) 3

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PETITIONER'S REPLY BRIEF

Question I

Respondent concedes the Circuit Court of Appeals decided that a typewritten thesis filed in a college library is a "printed publication" within the meaning of the Statute (R. S. 4886; U. S. C., title 35, Sec. 31) and does not deny that this Court has never passed on this important question of federal statute law. Respondent merely argues that the thesis in question was not the "determinative" ground of the Circuit Court of Appeals decision. Whether that Court based its conclusion on additional grounds is without significance. The significant factors, not denied by respondent, are that the question is presented, and that the question has not been but should be settled by this Court.

Question II

Respondent does not deny that this question as stated by petitioner conflicts with the lower Court decisions cited in petitioner's brief, and concedes the question has not been settled by this Court (respondent's brief, p. 3). Respondent denies that the question is presented. It is clear from a reading of the Circuit Court of Appeals' opinion at Rec. p. 729 that the question was passed on by that Court and is presented here. The Circuit Court of Appeals said:

> "the patentee has experimented with but 20 [compounds] falling within the scope of the claims as including the effective phenylmercuric radical in the form prescribed. Since all the compounds so made and tested were found to be effective, it is concluded that all within the group likewise are. But the patent is not limited to the results achieved by the patentee's research * * * the claims are too broad and so, under familiar rules, invalid." (Bracket insert petitioner's).

Question III

The question as presented by petitioner is not misleading. The Circuit Court of Appeals said the question was whether in view of the White article "nothing more was required than routine experimentation by the skilled chemist" (Rec. p. 728). In answering this question, the Court makes clear its position that "convincing evidence of seemingly insuperable difficulties encountered on the road * * *" is a necessary prerequisite to a finding that the patentee's discovery was invention rather than routine experiment. This is clearly in conflict with the established doctrine that the unique property of the thing discovered and not the ease or difficulty with which the discovery was made controls on the question of invention.

Question IV

This question is clearly presented. The Circuit Court of Appeals noted that Weed (the patentee) submitted to the rejection of his prior abandoned application on a seed disinfectant patent, and held this submission established an analogy between the arts of producing disinfectants for plants and germicides for humans (Rec. p. 730). Thus the Court held the patentee's former submission to be an estoppel on the question of anticipation by analogous art. The conflict between this ruling and that established by this Court is explained in petitioner's brief.

Respectfully submitted,

W. B. MORTON
Counsel for Petitioner

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RESPONDENT'S BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

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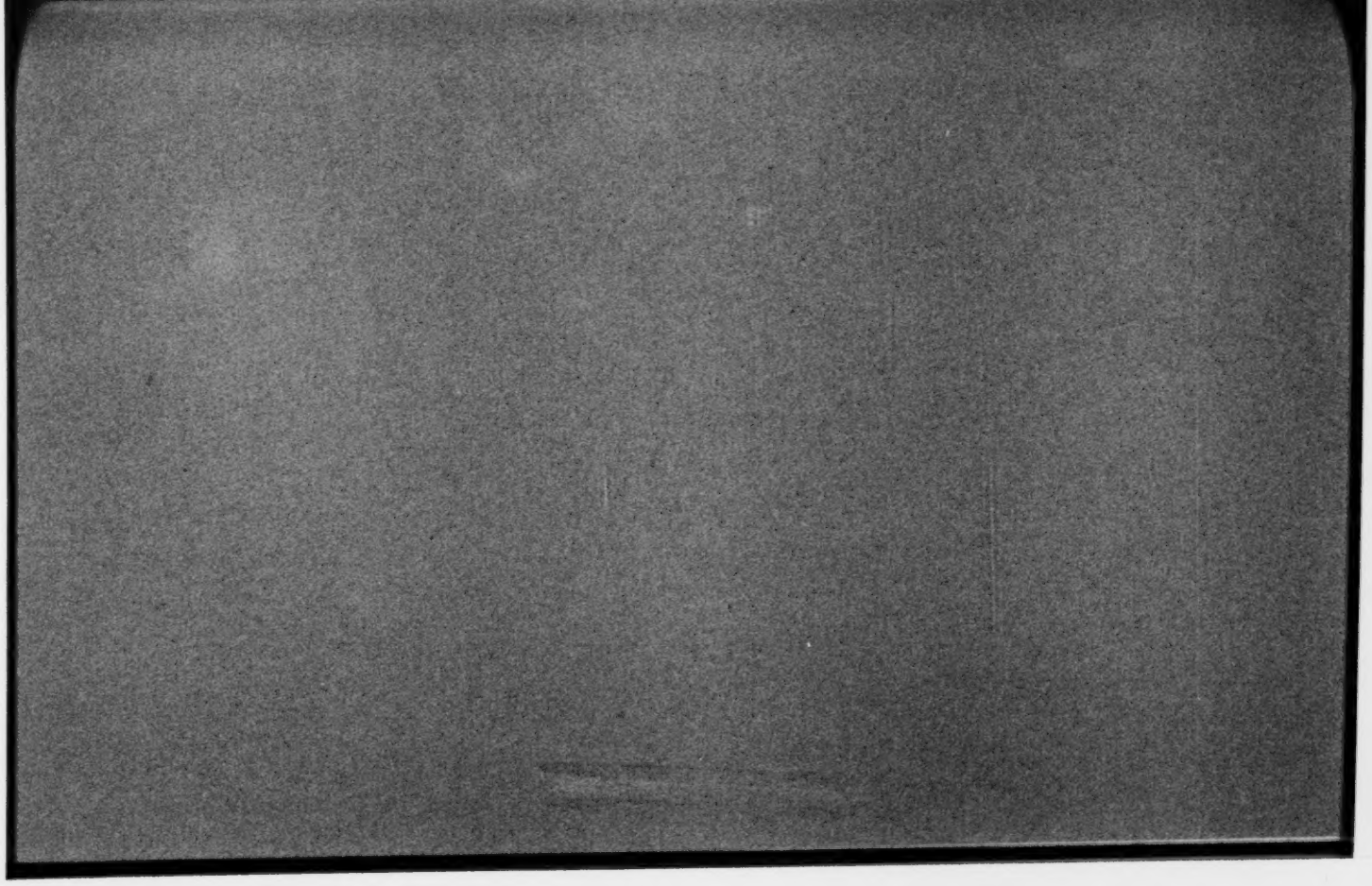

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Petitioner,

vs.

SAMUEL E. MASSENGILL, doing business as THE S. E. MASSENGILL COMPANY,
Respondent.

BRIEF FOR RESPONDENT IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

This is a suit for infringement of petitioner's patent to Weed, No. 2,014,676 (R. 251; offered R. 16) based on a continuation of an application filed July 29, 1932 (Stipulation, R. 255). The patent was held invalid both by the District Court (Record, pp. 229-236 and 25 F. Supp. 464), and by the Circuit Court of Appeals for the Sixth Circuit (R. 723-730 and 111 F. [2d] 584). No court has ever held the patent valid, and no conflict of decisions upon the issues of this case is presented.

The patent claims the therapeutic use as bactericides or fungicides of any one of a group of organic mercurials; the group admittedly (R. 54-56) including hundreds of

thousands of aryl mercuric compounds. The patent does not claim to have invented these compounds—they were old. It is undisputed that the particular methods by which the patentee diluted and applied the compounds did not differ from the methods by which mercuric germicides generally are administered. Thus invention was asserted only in allegedly discovering the therapeutic utility of mercurials of this vast group.

The petition at page 4 asserts that four numbered questions are here presented. Of these, only the first numbered question was actually decided by the Circuit Court of Appeals below, and that question was not regarded by that Court as determinative of the holding of invalidity herein. The alleged questions 2, 3 and 4 do not correspond to the holdings actually made by the Court and are not properly present here.

Question 1 asks whether a typewritten thesis filed in a college library (in 1928) is a "printed publication." This thesis (R. 413-442; offered R. 96) was not the "determinative" ground on which the Circuit Court of Appeals held the patent invalid. The District Court likewise had held the patent invalid, even though it had ruled that this thesis was not a printed publication (Finding 23, R. 241). The ruling on the point by the Circuit Court of Appeals (R. 723-724) states:

> "While perhaps not determinative of ultimate issues in the present case, the Weed thesis is in the prior art and marks a step in its development since it was put on file in the library of the college, available to students there and to other libraries having exchange arrangements with Iowa State."

The petition does not allege that this reasonable ruling is contrary to any decision of this Court or of the lower courts, and it is believed too unimportant as here presented to justify grant of the petition. Obviously, when,

as here, a student "publishes" a thesis, a patent application thereon filed by him more than two years later should be barred by R. S. 4886, 35 U. S. C. 31.

Question 2, said to be presented, is not actually in issue. The Circuit Court of Appeals did not in fact hold that a patent is necessarily invalid if drawn to cover a range of equivalents beyond the specific compounds actually used. It merely held (at R. 729) that the same test must be applied to the Weed patent in suit as to the 1924 White prior art publication (R. 625; offered R. 197). Both White (R. 726-727) and Weed recite specific examples and suggest a large class of compounds. The Court overruled appellant's contention that White had merely made a prophecy in recommending thousands of organic mercurials, since the patentee Weed would be subject to the same criticism in likewise covering thousands of the same organic mercurials without ever having tried more than twenty (R. 56). There is admittedly no contrary decision by this Court, and there is actually no conflict with the Patent Office and District of Columbia decisions cited.

Moreover, claims of the patent in suit did not in fact define a group having common properties which differ in more than degree from those admittedly outside the claims. The claims call for organic mercurials which ionize in water to place the mercury atom in the positively charged ion or cation leaving the balance of the compound in the negatively charged ion or anion (R. 251, first column, lines 13-16; offered R. 16). But organic mercurials have long been known as germicides and are admittedly effective, in which the substance ionizes in water to place the mercury atom in the negatively charged ion (R. 67 and 215). The theory on which the patent depends for claiming that the method of ionization is important, was admitted by petitioner's witnesses to be still a mere theory (R. 67) and not "a thing that you could say definitely yet

that that was true" (R. 29). Even if a difference in degree appears between the organic mercurials within and without the claims, the same thing is true of the organic mercurials which are wholly within the claims—they also differ in degree of effectiveness (R. 56). Petitioner's own advertising booklet (R. 370) points out some of these differences at pages 10, 13 and 16, and declines at page 21 even at the time of trial to recommend the patented compounds for internal use either intravenously or orally (see also R. 62). Thus, the group claimed is not "well defined" as petitioner asserts, and the claims might have been (but were not) held invalid on this ground without any conflict with the cases cited at pages 11 and 12 of petitioner's brief.

Question 3 is misleading. It appears to present to this Court the question of whether patentable invention may ever arise in chemical research—a possibility not disputed by the opinion of the Court of Appeals. The true question (R. 728) was whether patentable invention could result from merely determining, by obvious and easy laboratory testing, a utility which had been already described for this entire field by the prior White publication. There is nothing in this holding in conflict with the cited case of *Corona Co.* v. *Dovan Corporation*, 276 U. S. 358, 368-9, where the prior art (other than Kratz) had limited its teachings to T. P. G. and had not included reference to D. P. G. as an accelerator.

Question 4 is likewise misleading and not actually presented. The Court of Appeals did not hold that the patentee was "estopped to contest the pertinence" of the prior Kharasch patent 1,770,886. The Court pointed out (R. 730) that Weed had already, in the Weed and Ecker article of 1931 (R. 459 and 463; offered R. 114) and former application (R. 538, 539 and 541; offered R. 86), treated the disinfectant use of these organic mercurials for plants and seeds as analogous to their germicidal use for

animals or human beings, and had abandoned this earlier application when it had been rejected on the Kharasch patent (R. 581, lines 23-34; offered R. 197) which taught use of these mercurials for plants and seeds and mentioned that they were innocuous to the hands of the human user. Such conduct by patentee, before filing his application for the patent in suit, was an admission by him adding force to the showing that the two arts were analogous, but it was not held to estop petitioner from contesting the pertinence of the Kharasch patent. Nothing in the opinion is therefore in conflict with the cited case of *Smith* v. *Snow*, 294 U. S. 1, 16. It is believed further, however, that the permanent abandonment of an application following a citation, as occurred in the present case (R. 538), is a much plainer acquiescence than the cancellation of a narrow claim and the substitution of a broader one in the same application as occurred in *Smith* v. *Snow*.

Conclusion

The petition appears lacking in any of the ordinary grounds set forth in Rule 38, paragraph 5 of the Rules of this Court, for the issuance of a writ of certiorari, and the attempted showing of novel or unsound grounds for the decision below appears without substance.

Respectfully submitted,

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